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File No: 2796/1G216-US1



In Re Application of:

Masami MURAO and Yoshiaka MURAO

Serial No.: Continuation-in-part of U.S. Serial No. 09/418,794, filed October 15, 1999

Filed: Herewith

For: **STRUCTURE FOR ADJUSTING LENGTH OF ORNAMENT CHAINS**

PRELIMINARY REMARKS

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

This communication is in response to the outstanding Office Action dated September 12, 2000 in connection the parent application U.S. Serial No. 09/418,794, filed October 15, 1999. Consideration of the following arguments and remarks is request prior to examination of the above-identified Continuation-in-Part application on the merits.

REMARKS

In the outstanding Office Action dated September 12, 2000 issued in the parent application, the Examiner issued several grounds of objections and rejections that applicants submit have been overcome in this Continuation-in-Part application.

The drawings were objected to under 37 CFR §1.83(a) as failing to show the coupling means in claim 6. Applicants respectfully traverse the Examiner's objection to the drawings and direct the Examiner's attention to Figure 6 that shows constituting parts 9, 9' of exemplary coupling means, as found in claim 6.

In addition, the Examiner objected to the disclosure as failing to include a description of Figures 1(a) - 1(e) in the Brief Description of the Drawings section of the specification. Applicants have included an appropriate description of these figures in the Continuation-in-Part application. The Examiner also objected to the use of the term "Dharma". This term has been deleted from the present application.

Also on formal grounds, the Examiner objected to the Abstract. In the Continuation-in-Part application applicants have amended the Abstract to overcome the outstanding objections.

Claim 6 is rejected under 35 U.S.C. §112, first paragraph, in that the specification fails to adequately describe the structure of the coupling means. Specifically, the Examiner states that it is unclear how the coupling means is to be incorporated into the casings, nor how such coupling means would interact with one another. Applicants respectfully traverse the Examiner's rejection and assert

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that claim 6 clearly provides that the coupling means is used to releaseably couple the plural casings together. The specification of the present application and parent applications provide support for some illustrative examples of coupling means 9, 9' as found on page 7.

Claims 1-13 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. After pointing out a few examples, the Examiner noted that the claims contain too numerous problems to mention. Applicants have amended the claims accordingly in the Continuation-in-Part application to overcome the outstanding rejections under 35 U.S.C. §112, second paragraph. Most of the Examiner's rejections are self explanatory and have been overcome in the present application. Applicant does, however, wish to assert on the record remarks to several specific rejections raised by the Examiner.

In particular, the Examiner states that claim 1 is indefinite "in that it is not clear as to whether the structure for adjusting a length of a chain is being claimed *in combination* with the chain; for example the preamble of Claim 1 states 'A structure', with an intended use statement of 'for adjusting a length of an ornament chain'". As suggested by the Examiner in the outstanding Office Action, applicants confirm that the claims positively recite only the structure for adjusting the ornament chain, the ornament chain itself is not a claimed element.

It is well established in patent law that functional language may be used to describe a structural element without the claim being indefinite. MPEP 2173.05(g) provides that

"A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or

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specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step."

As espoused by the Court of Customs and Patent Appeals in the case In re Venezia, 189 USPQ 149 (CCPA 1976), claim 31 defined a splice connector kit including a pair of sleeves "adapted to be fitted over the insulating jacket" which imparts structural limitations to the sleeve. "We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components , or the attributes they must possess , in the completed assembly." Id. at 152. The court further stated that "although the claims before us contain some language which can be labeled 'conditional,' this language, rather than describing activities which may or may not occur, serves to precisely define present structural attributes of interrelated component parts of the 'kit' , such that a later assembly of the 'kit' of parts may be effected." Id. Applying these principles to the present claimed invention, applicants submit that the ornament chain itself is not positively recited and thus not a claimed element.

As for the prior art rejections, the Examiner rejects claims 1-4 and 7-13 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 1,504,761 (Hubbell). Claims 5 and 6 are rejected under 35

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U.S.C. §103(a) as obvious over Hubbell in view of U.S. Patent No. 4,665,595 (Viot).

Applicants submit that independent claim 1 is distinguishable over Hubbell. The present claimed invention is distinguishable both functionally and structurally over the prior art of record. In particular, the present claimed invention is directed to a retainer for adjusting the length of an ornament chain, whereas Hubbell discloses a clasp that is adapted to engage the end of a chain and retain the same in place. In summary, the Hubbell device is nothing more than a closing element for closing the open end of a key chain or a necklace.

The present claimed invention is also structurally distinguishable over that of Hubbell.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner refers to FIG. 10 of Hubbell that shows one end of a chain 23 that is permanently received in an end 28 of the clasp. Received within a container 27 is a clip comprising side members 18 made of resilient material and which are inserted into an opening 16 (FIG. 1) of the casing. A peripheral groove 23, 24 surrounds the upper enlarged end 20 of the members 18 (see FIG. 7). A member 25 joins the end of the members 18 in such a manner that the upper ends 20 of the clip may be separated.

In operation, an opposite end 32 is inserted into the rounded portion 20 of the clip which, in turn, is then inserted into the casing 27 and pushed downwardly through the opening 16 until the ends of the opening are received in the shoulders 23 and 24 thereby pushing together the members 20 and capturing the end member 32 therein. When it is desired to open the chain, the members 18 are pulled

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upwardly and the members 20 separated to permit removal of the ball 32.

The retainer of claims 1, 13 and 15 expressly call for the casing to be adapted "to allow the ornament chain to pass therethrough", whereas the openings in clasp 27 capture the chain 26 thereby intentionally preventing it from passing therethrough.

Claims 1 and 13 further provide that the resilient member has "a diameter sufficiently small to produce an urging force in a direction toward an outer periphery of the ornament chain when fitted in the resilient member". In contrast, side members 18 are not sufficiently small in diameter to exert an urging force in a direction toward the outer periphery of chain 26. Furthermore, claim 1 states that "when the ornament chain protruding from said retainer is pulled, said resilient member abuts against an inner wall of the casing so as to be restrained, and upon application of additional force, the ornament chain is pulled out from said resilient member, overcoming the urging force of said resilient member so as to adjust the length of the ornament chain". Thus, in the present claimed invention the resilient member 4 exerts an inwardly directed force on the ornament chain to hold it in place. When it is desired to vary the length of the ornament chain, a force is exerted on the chain sufficient to overcome the urging force of the resilient member thereby allowing the ornament chain to be adjusted in length. To the contrary, the Hubbell device secures the chain in place by capturing one of its beads or balls at either end. If one pulls the chain of the Hubbell device, it will not permit the chain to pass through the casing shown in FIG. 10. Instead, if the force is great enough, the clip comprising the members 18 will simply move outwardly of the casing 27 and release the chain 32. Accordingly, applicants submit that independent claim 1 is patentable over the art of record.

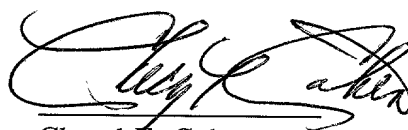
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Dependent claims 3 and 14 and independent claim 15 are further distinguishable over the art of record in that "the ends of said resilient member abut against an inner wall of said casing proximate the respective ports" (emphasis added). In contrast only one end of the side members 18 of the clip 17 in the Hubbell device abut the inner wall of the body portion of the clasp 27.

Applicants submit that independent claims 1, 13 and 15 are allowable over the prior art of record for at least the reasons discussed above. Claims 2-12 depend from independent claim 1 and thus are patentable over the art of record for the same reasons that claim 1 is patentable. Claim 14 depends from independent claim 13 and thus is patentable over the art of record for the same reason that claim 13 is patentable. Dependent claims 3 and 14 are further distinguishable over the art of records for the reasons discussed above.

An early and favorable action on the merits is respectfully requested.

Respectfully submitted,



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